

REMARKS

In the Office Action mailed May 17, 2010, a concern was noted by the Examiner regarding a previously submitted Information Disclosure Statement (IDS).

Claims 6, 9-10 and 16 were rejected under 35 USC §112, second paragraph for alleged indefiniteness.

The Examiner rejected claims 1-2, 6, 10, and 19 under §102 for alleged anticipation by US 6,251,416 to Narayanan et al.

The Examiner also rejected claims 1-2, 6, 10 and 19 under §102 for alleged anticipation by WO 03051375.

The Examiner also rejected claims 1-6, 9-10, and 19 under §103 for alleged obviousness based upon US 6,149,898 to Peffly et al. in view of EP 0 459 500.

In addition, the Examiner rejected claims 11-16 under §103 for alleged obviousness based upon the noted US '898 patent, in view of EP '500, and further in view of WO 2004/024114.

Applicant appreciates the careful and thorough review of the present application. Amendments are presented herein to claims 1, 6, 9, 10, 11, and 16. It is respectfully submitted that in view of the clarifications presented herein, claims 1-6, 9-16 and 19 are all in condition for allowance.

A. Previously Submitted IDS

On page 2 of the Office Action, the Examiner noted that "Form PTO/SB/08a" was not included with the previously submitted Information Disclosure Statements.

Enclosed herewith are copies of the Forms PTO/SB/08a.¹

Consideration of the previously filed IDS's in light of the enclosed Forms PTO/SB/08a is respectfully requested.

B. Rejections Should Be Withdrawn

1. Rejection of Claims 6, 9-10 and 16 Under §112, Second Paragraph Should be Withdrawn

Claims 6 and 16 have been amended to replace the former term "water-miscible solvent" with "dimethyl ether compound." This amendment is in accordance with an amendment to corresponding independent claim 1 and 11, described below. The amendments to claims 6 and 16 are believed to remedy the antecedent basis difficulty noted by the Examiner.

Claims 9 and 10 have been amended to recite that the reference to "compound" is to "dimethyl ether compound." This amendment is also in accordance with the clarification described below.

It is believed that the §112 difficulties have been remedied and the rejection should be withdrawn.

¹ In Applicant's previous filing on February 3, 2010, two IDS's were submitted: (i) a Supplemental IDS in which three articles were referenced, and (ii) an IDS citing two Japanese publications.

2. Rejection of Claims 1-2, 6, 10 and 19 Under §102 by US 6,251,416 to Narayanan et al. Should be Withdrawn

US Patent 6,251,416 to Narayanan et al. discloses the use of PLURONIC® L31. The Examiner asserted that this agent corresponds to component (D) in the claims at issue.

Independent claims 1 and 10 have been amended to recite that the claimed one-phase microemulsion composition comprises in part as component (D), a "dimethyl ether compound of polypropylene glycol/polyethylene glycol copolymer" having certain characteristics.²

The recited dimethyl ether compound of independent claims 1 and 10 expressly excludes the PLURONIC® L31 material disclosed by Narayanan et al. As the Examiner correctly notes, PLURONIC® L31 is an EO/PO block copolymer surfactant. The mention of using PLURONIC® L31 in the '416 patent is not a disclosure of the dimethyl ether compound as now recited in the claims at issue. Moreover, the '416 patent entirely fails to disclose the particular dimethyl ether compound as now recited in the claims at issue. Accordingly, the '416 patent fails to anticipate under §102 any of claims 1 or 10, or claims 2, 6, and 19 dependent therefrom.

For at least these reasons, it is respectfully submitted that the present rejection must be withdrawn.

² No new matter is added by this amendment as support is found throughout the application as originally filed. For example, dimethyl ether compounds are used as component (D) in many if not most of the examples in the specification.

3. Rejection of Claims 1-2, 6, 10 and 19 Under §102 by WO 03051375 Should be Withdrawn

WO 03051375 discloses poloxamer 101 which is an EO/PO block copolymer. The Examiner contended that this agent corresponded to component (D) in the claims at issue.

Independent claims 1 and 10 have been amended as previously explained to now specifically recite component (D) as a particular dimethyl ether compound. This amendment expressly excludes the poloxamer component disclosed in the WO '375 publication. Further, the WO '375 publication entirely fails to disclose the particular dimethyl ether compound called for in the amended claims. Accordingly, the WO '375 publication fails to anticipate under §102 any of claims 1 or 10, or claims 2, 6, and 19 dependent therefrom.

For at least these reasons, it is respectfully submitted that the present rejection based upon the WO '375 publication must be withdrawn.

4. Rejection of Claims 1-6, 9-10, and 19 Under §103 by US 6,149,898 to Peffly et al. in view of EP 0 459 500 Should be Withdrawn

US 6,149,898 to Peffly et al. describe the use of various copolymers available under the PLURONIC® designation in microemulsions. However, Peffly et al. teach that the PLURONIC® agents function as surfactants in the microemulsions. That is Peffly et al. recognize the PLURONIC® agents as surfactants, see col. 7, lines 66-67. This is in accordance with information provided by BASF (the supplier of the PLURONIC® agents) on its website. The PLURONIC copolymers are in fact, surfactants.

In contrast, the dimethyl ether compound recited in all pending claims is not a surfactant. That is, the dimethyl ether compound does not exhibit surface activity. One following the teachings of the '898 patent to Peffly et al. would be motivated to investigate the use of one or more surfactants in a microemulsion. There is absolutely no teaching or even suggestion in the patent to Peffly et al. of using a dimethyl ether compound as now recited in all pending claims.

The EP '500 publication fails to remedy the deficiencies of the '898 patent to Peffly et al. Furthermore, it is believed that upon further review, the Examiner will appreciate that the EP '500 publication is not particularly relevant to the claims as now amended.

In view of the foregoing, it is respectfully submitted that the present rejection should be withdrawn.

5. Rejection of Claims 11-16 Under §103 by US 6,149,898 in View of EP 0 459 500, and Further in View of WO 2004/024114 Should be Withdrawn

Claims 11-16 have been amended by an amendment to independent claim 11 calling for component (D) to be a dimethyl ether compound of a polypropylene glycol/polyethylene glycol copolymer having certain characteristics. As previously explained, neither of the US '898 patent nor the EP '500 publication teach or even suggest such a compound. Instead, these references teach away by their express teachings of using surfactants. As noted, the recited dimethyl ether compound is not a surfactant.

The WO '114 publication fails to remedy the deficiencies of the US '898 patent and the EP '500 publication.

It is respectfully submitted that upon further review, the Examiner will appreciate that claims 11-16, particularly as now amended, are patentably distinguishable from the cited references.

In view of the foregoing, it is submitted that the present rejection should be withdrawn.

C. Conclusion

In view of the clarifications and amendments presented herein, it is respectfully submitted that all claims 1-6, 9-16, and 19 are in condition for allowance.

If there are any fees resulting from this communication, please charge same to our Deposit Account No. 18-0160, our Order No. IWI-16715.

Respectfully submitted,

RANKIN, HILL & CLARK LLP

By /Mark E. Bandy/
Mark E. Bandy, Reg. No. 35788

38210 Glenn Avenue
Willoughby, Ohio 44094-7808
(216) 566-9700